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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,697	10/20/2003	Kazuo Kaneko	00862.023288.	2836
5514 7590 11/12/2009 FITZPATRICK CELLA HARPER & SCINTO 1290 Avenue of the Americas NEW YORK, NY 10104-3800				
EXAMINER				
PHAM, LINH K				
ART UNIT		PAPER NUMBER		
2174				
MAIL DATE		DELIVERY MODE		
11/12/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/687,697

**Applicant(s)**

KANEKO ET AL.

**Examiner**

LINH K. PHAM

**Art Unit**

2174

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 27-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 27-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***DETAILED ACTION***

1. This Office Action is in response to the Request for Continued Examination filed on 08/13/2009.
2. In the Instant Amendment, Claims 1, 3, 4, 11-17 and 19 were canceled; Claims 27 and 29 are independent claims; Claims 27-30 have been examined and are pending.

**This Action is made NON-FINAL.**

***Continued Examination Under 37 CFR 1.114***

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08/13/2009 has been entered.

***Specification***

4. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phrasology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure

sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

### ***Priority***

5. Applicant is reminded that in order for a patent issuing on the instant application to obtain the benefit of priority based on priority papers filed in parent Application No. JP 2002-305832 under 35 U.S.C. 119(a)-(d) or (f), a claim for such foreign priority must be timely made in this application. To satisfy the requirement of 37 CFR 1.55(a)(2) for a certified copy of the foreign application, applicant may simply identify the application containing the certified copy.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(c) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this

subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. **Claims 27 and 29-30 are rejected under 35 U.S.C. 102(\*)** as being anticipated by Beyda et al., ("Beyda", US 2001/0014146).

**Regarding claim 27**, Beyda discloses an information processing apparatus for executing a predetermined procedure corresponding to a command designated by a user, the apparatus comprising:

a database which holds plural candidates corresponding to plural commands (*paras. 0027-0030; Fig. 1; menu presentation, subject line or folder hierarchy. which are known as plural command, are stored in a storage device 104*);

a selection unit which selects a command group, which includes some commands which relate, in response to the user operation (*paras. 0041-0049; Figs. 3-5; the welcome message 202 may provide entry to a first hierarchical level 204 of menus or prompts. A plurality of prompts 204a-204c are then presented one after the other*);

a decision button which is operable by the user (*paras. 0041-0049; Figs. 3-5; the user may be given the option of pressing a particular button or speaking a particular phrase to proceed to a next function or level at each prompt*);

a voice output unit which outputs each candidate as voice information from the candidates, which correspond to the commands included in the selected command group, one at a time (*paras. 0041-0049; Figs. 3-5; next function/command will be proceed by user*); and

a determination unit which determines a command designated by the user, wherein, when the user operates the decision button during the voice information corresponding to one candidate that is output by the voice output unit, the determination unit determines a command corresponding to that candidate as the designated command, and when the user operates the decision button during the voice information corresponding to another candidate that is output by the voice output unit, the determination unit determines a command corresponding to the other candidate as the designated command (*paras. 0014, 0041-0049; Figs. 3-5; paras. 0053-0054; at step 306; user can select a function key or speak a command during presentation of a prompt message then the system will determine and present a next prompt to user*).

**Regarding claim 29**, claim 29 is similar in scope to claim 27, and is therefore rejected under similar rationale.

**Regarding claim 30**, claim 30 is similar in scope to claim 27, and is therefore rejected under similar rationale.

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
10. **Claim 28 is rejected under 35 U.S.C. 103(a)** as being unpatentable over Beyda et al., (“Beyda”, US 2001/0014146) in view of Epler et al., (“Epler”, US 6,026,156).

**Regarding claim 28**, Beyda discloses the information processing apparatus according to claim 27.

Beyda does not explicitly disclose if the user operates the decision button between the end of the voice information output of a previous candidate, and the start of the voice information output of a subsequent candidate, the determination unit determines a command corresponding to the previous candidate as the designated command.

However, Epler teaches a system for providing telecommunication services to a user, wherein, if the user operates the decision button between the end of the voice information output of a previous candidate, and the start of the voice information output of a subsequent candidate, the determination unit determines a command corresponding to the previous candidate as the designated command (*col. 10, line 67 to col. 11, lines 1-10; Figs. 4A-4C, at*

*step 212, inactive timeout or disconnect detected, the system will check if the user is still on the line the system control will return to step 208).*

Therefore, it would have been obvious to an artisan at the time invention was made to combine the teachings of Epler with the system of Beyda, in order to provide users with a means for providing an enhanced call waiting telecommunication service to a user when the user is engaged in a telephone conversation via a telephone switch with a first party at the same time a second party attempts to place a telephone call to the user (*col. 2, lines 5-10*).

### ***Response to Arguments***

11. Applicant's arguments with respect to claim 27-30 have been considered but are moot in view of the new ground(s) of rejection.

### ***Inquiries***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LINH K. PHAM whose telephone number is (571)270-3230. The examiner can normally be reached on Monday to Thursday from 7:30AM to 5:00PM (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doon Y. Chow can be reached on (571) 272-7767. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/DENNIS-DOON CHOW/  
Supervisory Patent Examiner, Art Unit 2174

October 22, 2009  
/Linh K. Pham/  
Examiner, Art Unit 2174